

RE MARKS

Reconsideration of the above-identified application respectfully requested.

Claims 1-5 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim that which applicants regard as the invention. Applicants' amendments to the claims in response thereto are listed above and also are detailed in the attached Marked-Up Set of Amended Claims.

With respect to claims 3 and 4, Applicants respectfully submit that the language of these claims as filed is definite and unambiguous. Alternative expressions using "or" are considered acceptable. See Manual of Patent Examining Procedure, § 2173.05(h)(II). However, to materially advance prosecution and because Applicants view the Examiner's proposed language as being identical in scope, *i.e.*, not narrowing, Applicants have made the Examiner's recommended amendments. Claim 3 has been amended to recite "part is composed of material selected from the group consisting of metal, composite, glass or combinations thereof." Claim 4 has been amended to include the identical language proposed by the Examiner.

No new matter is added by virtue of these claim amendments. Moreover, such claim amendments are ministerial as they relate to inadvertent errors in the nature of typographical, grammatical or similar errors. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, __ US __, 112 S.Ct. 1831, 152 L.Ed.2d 944, 62 USPQ2d 1705 (2002)). See also *Interactive Pictures Corp. v. Infinite Pictures Inc.*, Fed Cir., No. 01-1029, December 20, 2001 (addition of the words "transform calculation" was not a narrowing amendment because that addition did nothing more than make express what had been implicit in the claim as originally worded).

Before considering the art rejections, Applicants would like to provide a brief description of the claimed invention and the advantages that the invention provides. The claimed invention is directed to a method for packaging an automobile part for shipment. The automobile part is placed on the front of a piece of paperboard such that areas on the front of the paperboard are left exposed. Shrink wrap then is applied over the automobile part and the exposed areas of the paperboard. Using the claimed method, the resulting paperboard laminate assembly prevents objects being shipped from moving, shifting, or otherwise changing position during loading, shipping, and storage. The inventive method may be utilized for packaging small items, but its advantages are most fully appreciated when the automobile part is large and heavy, *e.g.*, a window glass, door panel, hood, fender, etc. Surprisingly, with the claimed method, a paperboard backing combined with the noted shrink-wrapping is sufficient to protect such cumbersome items from breakage, scratches, dents, and abrasions.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,154,898 issued Engles, Jr. (hereinafter, "Engles, Jr.").

In making this rejection, the Examiner notes that Engle discloses that it is well-known in the prior art to utilize a backing comprised of paperboard. While the use of paperboard is cited in the background of Engles, Jr., Engles, Jr. specifically teaches away from the use of paperboard because of the problems associated with it. In particular, Engles, Jr. notes that paperboard backing are "not water impervious, tend to curl under stress, and require the use of an adhesive to secure a firm bond between the backing and the film overlay." Col. 1, lines 15-18. To overcome these problems, Engles, Jr. specifically rejects paperboard as an effective backing or substrate and uses foam instead. See, Col. 1, lines 19-23. When viewed as a whole, Engles, Jr. teaches that attempts to use paperboard were unsuccessful.

Further, there is no suggestion in Engles, Jr. that paperboard could be used with large automotive parts, such as windshields, doors, fenders, etc. Engles, Jr. discloses the packaging of an "article". The only article specifically disclosed is a spark plug. See, Figs. 1-3 and the Examples at Col. 3, line 24-Col. 4, line 2. Thus, Engles, Jr. teaches away from paperboard even for small articles, let alone larger automotive parts.

Claim 3, dependent on claim 1, further recites that the automobile part is composed of material selected from the group consisting of metal, composite, glass, or combinations thereof. As noted above, the only article disclosed in Engles, Jr. is a spark plug. A major advantage of the present method is that it may be used to package large glass parts, such as windshields. There is no disclosure nor suggestion in Engles, Jr. for packaging any type of glass articles.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr.. Particularly, the Examiner has taken Official Notice that it is old and well-known to package various types of automotive parts for the purpose of protecting the part from damage. The Examiner argues that nothing disclosed by the applicants makes packaging a specific article patentably distinct from the generic article, and, therefore, providing the Engles, Jr. invention with window glass, door panel, fender or hood would have been obvious.

In response, Applicants would first note that, as described above, Engles, Jr. emphatically teaches against the use of paperboard for the packaging of any article. Applicants would further note that, rather than being obvious, the successful use of paperboard for backing a large and heavy item is unexpected and surprising. Such disparity of weight and size exists between paperboard and a large automotive part, that use of paperboard with such parts as a backing is counterintuitive. This is true even when the paperboard is laminated for additional strength. In this regard, the Examiner has cited no reference that discloses the packaging of a large automotive part using paperboard. As a result, Applicants submit that the items recited in claim 4 (window glass, door panel, fender or hood) are patentably distinct from the generic

article disclosed in Engles, Jr. and, it would not have been obvious to substitute any of these items for Engles, Jr.'s spark plug.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 4,611,456 issued to Gillio-tos, et al. (hereinafter, "Gillio-tos"). The Examiner cites Engles, Jr. as disclosing all the elements of claim 2 except a laminate backing. The Examiner cites Gillio-tos as disclosing a laminate backing.

Applicants would first note that claim 2, dependent on claim 1, recites the step of providing paperboard. That step, as discussed above, is neither disclosed nor taught by Engles. Claim 2 further recites that "said paperboard comprises laminated plies of paperboard." Gillio-tos discloses a substrate that may be provided as a laminated multilayer material. However, Gillio-tos also states that, "As for the material that may be used in the substrate construction, the single requisite is that it be a thermoformable material...". Col. 3, lines 16-20. Paperboard is not a thermoformable material. Thus, neither Engles, Jr. nor Gillio-tos disclose or suggest the use of a paperboard backing composed of laminated plies of paperboard.

Finally, claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engles, Jr. in view of U.S. Patent No. 6,010,003 issued to Wilkinson (hereinafter, "Wilkinson"). Claim 5 is dependent on claim 1 and further includes the step of placing the shrink-wrapped automobile part in a container. Claim 5 is patentable for the reasons given above in connection with claim 1.

In view of the amendments and remarks submitted herewith, allowance of the claims and passage to issue of this application respectfully requested.

Respectfully submitted,

Date:

Jan 23, 2003

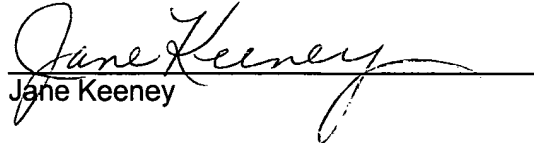
Diane E. Burke

Diane E. Burke
Reg. No. 45,725
Mueller and Smith, L.P.A.
Mueller-Smith Building
7700 Rivers Edge Drive
Columbus, Ohio 43235-1355
Tel.: 614-436-0600
Fax: 614-436-0057
email: dburke@muellersmith.com

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Jane Keeney

MARKED-UP SET OF AMENDED CLAIMS
SERIAL NO. 09/865,229

1. Method for packaging an automobile part for shipment, which comprises the steps of:
 - (a) providing a paperboard having a front and a back;
 - (b) placing an automobile part on the front of said paperboard leaving exposed areas of said front of said paperboard laminate; and
 - ~~(b)~~ (c) shrink-wrapping with plastic shrink wrap material said ~~an~~ automobile part ~~product~~ to said paperboard laminate and said exposed areas of said front of said paperboard laminate.
2. The method of claim 1, wherein said paperboard ~~laminate~~ comprises laminated plies of paperboard.
3. The method of claim 1, wherein said automobile ~~parts are composed of one or more of~~ metal, composite, or glass part is composed of material selected from the group consisting of metal, composite, glass or combinations thereof.
4. The method of claim 3, wherein said automobile ~~parts are one or more of window glass, door panel, hood, or fender~~ part is selected from the group consisting of window glass, door panel, hood, fender or combinations thereof.
5. The method of claim 1, wherein said shrink-wrapped automobile part of step (c) is placed in a container.



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Drawing
S. Zimmerman

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PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/865,229	
	Filing Date	May 25, 2001	
	First Named Inventor	Donald R. Youell, Jr.	
	Group Art Unit	3721	
	Examiner Name	Paul Durand	
Total Number of Pages in This Submission	14	Attorney Docket Number	ACP 2-021

ENCLOSURES (check all that apply)		
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Remarks		TECHNOLOGY CENTER R3700
Clean and Marked-up claims New set of drawings with missing reference numbers		

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Firm or Individual name	Diane E. Burke Mueller and Smith, LPA
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